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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,887	09/06/2005	Brian Leslie Smalley	R031 1160.1	4424
26158 7590 10/18/2010 WOMBLE CARLYLE SANDRIDGE & RICE, PLLC ATTN: PATENT DOCKETING P.O. BOX 7037 ATLANTA, GA 30357-0037				
			EXAMINER COLLINS, MICHAEL	
			ART UNIT 3651	PAPER NUMBER
			MAIL DATE 10/18/2010	DELIVERY MODE PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/523,887
Filing Date: September 06, 2005
Appellant(s): SMALLEY ET AL.

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EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/15/2010 appealing from the Office action mailed 1/21/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
Claims 1-2, 4, 6, 9, 60-66, 70-73, and 75-76 are rejected and pending.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office

action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,878,947

HOY et al.

3-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 9, 60-66, 70-73, and 75-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoy et al. (USP 5,878,947).

Regarding claim 1, Hoy et al. disclose a paperboard carton for articles arranged in an end-on-end relationship, the carton comprising:

- six sides (20/18,14,16,12,30/32,40/42), the six sides including a first side (30/32) disposed between a second side (14) and a third side (12), the first side being

perpendicular a fourth side (16), the second side (14), and the third side (12), the second side and the third side being parallel (see Figure 1),

- a two-piece dispenser (30A/32A,58,60,62) that includes a first portion (58,60,62) and a second portion (30A/32A);
- the first portion (58,60,62) defined at least partially along its perimeter by a first tear line (see Figure 5);
- the first portion (58,60,62) extending at least partially into the first side, the second side, and the third side (see Figures 4-7);
- the first portion (58,60,62) being removable from the carton along the first tear line to create a first opening for article removal (see Figure 7), the second portion (30A/32A) being adjacent the first portion (58,60,62) and being defined at least partially along its perimeter by the first tear line, a first provision (12A), and a second provision (14A);
- the first provision (12A) having a first end proximate the first portion and a second end distal the first portion (see Figures 5-6), the second end of the first provision (12A) being intersected by a first intersection line that prevents the first provision from extending beyond its intended length (see Figures 1-2 and 4-7);
- the second provision (14A) having a first end proximate the first portion and a second end distal the first portion (see Figure 4), the second end of the second provision being intersected by a second intersection line that prevents the second provision from extending beyond its intended length (see Figures 2, 4, and 7);

- the second portion (30A/32A) being separable along the first provision (12A) and the second provision (14A) to create a second opening in the carton (see Figures 2, 3, and 7);
- wherein the second opening and the first opening together define an enlarged opening, the enlarged opening enabling easier article removal from the carton than the first opening alone (see Figures 2, 3, and 7).

Regarding claim 6, Hoy et al. disclose the carton of claim 1 wherein the first provision and the second provision are parallel (see Figure 7).

Regarding claim 9, Hoy et al. disclose the carton of claim 1 wherein the six sides are arranged substantially rectangular (see Figures 1-4).

Regarding claim 60, Hoy et al. disclose the carton of claim 1 wherein the first tear line defines a perimeter section of the second portion (30A/32A) in the first side (30/32).

Regarding claim 61, Hoy et al. disclose the package of claim 64 wherein the first tear line defines a perimeter section of the second portion (30A/32A) in the first side (30/32).

Regarding claim 62, Hoy et al. disclose the carton of claim 1, wherein the first and second provisions are cuts (see Figures 4-7).

Regarding claim 63, Hoy et al. disclose the carton of claim 1, wherein the first and second intersection lines are cuts (see Figures 2, 4, and 7).

Regarding claim 64, Hoy et al. disclose a package comprising:

- a plurality of articles (52);

- a paperboard carton (10) for enclosing the plurality of articles in rows, the carton comprising:
 - six sides (20/18,14,16,12,30/32,40/42), the six sides including a first side (30/32) disposed between a second side (14) and a third side (12), the first side (30/32) being perpendicular a fourth side (16), the second side (14), and the third side (12), the second side and the third side being parallel (see Figures 1-4),
 - a two-piece dispenser (30A/32A,58,60,62) that includes a first portion (58,60,62) and a second portion (30A/32A);
 - the first portion (58,60,62) defined at least partially along its perimeter by a first tear line (see Figures 1 and 4-6);
 - the first portion (58,60,62) extending at least partially into the first side, the second side, and the third side (see Figures 1 and 4-6);
 - the first portion (58,60,62) being removable from the carton along the first tear line to create a first opening for article removal (see Figures 2, 3, and 7), the second portion (30A/32A) being adjacent the first portion (58,60,62) and being defined at least partially along its perimeter by the first tear line (see Figures 1-2 and 5-7), a first provision (12A), and a second provision (14A);
 - the first provision (12A) having a first end proximate the first portion and a second end distal the first portion (see Figures 1 and 4-6), the second end of the first provision being intersected by a first intersection line that

prevents the first provision from extending beyond its intended length (see Figures 2, 4, and 7);

- the second provision (14A) having a first end proximate the first portion and a second end distal the first portion (see Figure 4), the second end of the second provision being intersected by a second intersection line that prevents the second provision from extending beyond its intended length (see Figures 2, 4 and 7);
- the second portion (30A/32A) being separable along the first provision and the second provision to create a second opening in the carton (see Figures 2-3 and 7);
- wherein the second opening and the first opening together define an enlarged opening, the enlarged opening enabling easier article removal from the carton than the first opening (see Figures 2-3 and 7).

Regarding claim 65, Hoy et al. disclose the package of claim 63, wherein the first and second provisions are cuts (see Figures 1 and 4).

Regarding claim 66, Hoy et al. disclose the package of claim 63, wherein the first and second intersection lines are cuts (see Figures 1 and 4).

Regarding claim 70, Hoy et al. disclose the carton of claim 1 wherein the second portion (30A/32A) is hingeable at the first intersection line and the second intersection line (see Figures 2 and 7).

Regarding claim 71, Hoy et al. disclose the package of claim 64 wherein the second portion is hingeable at the first intersection line and the second intersection line

(see Figures 2 and 7).

Regarding claim 72, Hoy et al. disclose the carton of claim 1 wherein the first side and the fourth side intersect at a fold line and wherein the first intersection line and the second intersection line are spaced from the fold line (see Figure 4).

Regarding claim 73, Hoy et al. disclose the package of claim 64 the first side and the fourth side intersect at a fold line and wherein the first intersection line and the second intersection line are spaced from the fold line (see Figure 4).

Regarding claim 75, Hoy et al. disclose the carton of claim 1 wherein the first portion is removable from the second portion (see Figures 5-7).

Regarding claim 76, Hoy et al. disclose the package of claim 64 wherein the first portion is removable from the second portion (see Figures 5-7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoy et al. (USP 5,878,947) as applied to claims 1, 6, 9, 60-66, 70-73, and 75-76 above.

Regarding claim 2, Hoy et al. disclose the carton of claim 1. However, they do not disclose a carton wherein a divider pad is secured to the inside of the carton. Yet, adding this feature would have been obvious because the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Regarding claim 4, Hoy et al. disclose the carton of claim 2. However, they do not disclose a carton wherein the divider pad has a fold down gluing panel. Yet, adding this feature would have been obvious because the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

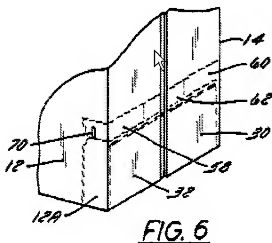
(10) Response to Argument

Issue 1: Are claims 1, 6, 9, 60-66, 70-73, and 75-76 anticipated by Hoy et al. under 35 U.S.C. § 102(b)?

Rule: While anticipation requires the disclosure of each and every limitation of the claim at issue in a single prior art reference, it does not require such disclosure *in haec verba*. In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977). In addition, it does not require that the prior art reference "teach" what the application at issue teaches. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983). Finally, Applicant is reminded that during examination claim limitations are

to be given their broadest reasonable reading. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Analysis: Appellant argues claims 1 and 64 recite a "first portion being removable from the carton" and that Hoy et al. "fails to provide a portion that is removable from the carton" and, therefore, "cannot be found to anticipate independent claims 1 or 64, or the claims that depend therefrom." However, Figure 6 of the reference discloses a strip bounded by lines of perforation which enable a portion to be removed.



Furthermore, Appellant argues that "the strip 62 is not removable from the carton." However, the reference discloses a package made of paperboard (see column 1 line 6). Consequently, the lines of perforation in combination with the material provides a disclosure which enables a first portion to be removed from the carton as disclosed by Appellant in claims 1 and 64. With regard to a broad and reasonable reading of "the first portion being removable from the carton" it should also be noted that Webster's II Dictionary (Third Ed. 2005.) defines remove as "To move from a position occupied" and

removable as "The act of removing." As shown in Figure 2 strips (58,60) are removed (as in their previously occupied position) from the carton of Figure 1 in order to make the stop (56) and new carton of Figure 2. Therefore, this argument is not convincing.

Conclusion: The rejection should be maintained.

Issue 2: Are claims 2 and 4 unpatentable under 35 USC 103(a) over *Hoy et al.*?

Rule: The disclosures in a reference must be evaluated for what they would fairly teach one of ordinary skill in the art. In re Snow, 471 F.2d 1400, 176 USPQ 328 (CCPA 1973); In re Boe, 355 F.2d 961, 148 USPQ 507 (CCPA 1966). Specifically, in considering the teachings of a reference, it is proper to take into account not only the specific teachings of the reference, but also the inferences that one skilled in the art would reasonably have been expected to draw from the reference. In re Preda, 401 F.2d 825, 159 USPQ 342 (CCPA 1968); In re Shepard, 319 F.2d 194, 138 USPQ 148 (CCPA 1963). In addition, it is proper to take into consideration not only the teachings of the prior art, but also the level of ordinary skill in the art. In re Luck, 476 F.2d 650, 177 USPQ 523 (CCPA 1973). Specifically, those of ordinary skill in the art are presumed to have some knowledge of the art apart from what is expressly disclosed in the references. In re Jacoby, 309 F.2d 513, 135 USPQ 317 (CCPA 1962).

Analysis: Appellant argues the rejection of claims 2 and 4 should be withdrawn because "(1) *Hoy et al.* fails to teach or suggest each and every element and (2) if the stop 56 of *Hoy et al.* were removed as proposed by the Examiner, the resulting carton would be rendered unsatisfactory for its intended purpose of providing a dispensing feature with a retaining means to retain one can at a time and would change the

principle of operation of *Hoy et al.*” As noted above, *Hoy et al.* provides a disclosure which enables a portion to be removed from the carton. Additionally, the stop (56) does not need to be completely removed in order to anticipate the claims because Appellant does not claim removal in such a way that requires actual separation from the carton. Therefore, this argument is not convincing.

Conclusion: The rejection should be maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Michael K Collins/

Examiner, Art Unit 3651

/Gene Crawford/

Supervisory Patent Examiner, Art Unit 3651

Conferees:

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